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Hearing:
June 5, 1997

Paper No. 20
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Isolab, Inc.
v.
Genzyme Corporation

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Opposition No. 97,778
to application Serial No. 74/535,956
filed on June 8, 1994

Gail L. Morrissey and Roger Gilcrest of Standley & Gilcrest for Isolab, Inc.

William G. Gosz and F. Brad Salcedo for Genzyme Corporation.

Before Simms, Quinn and Hairston, Administrative Trademark Judges.

Opinion by Quinn, Administrative Trademark Judge.

An application has been filed by Genzyme Corporation to register the mark DIRECT LDL ("LDL" disclaimed) for "diagnostic reagents for the immunoseparation of cholesterol components in vitro."[1]

Registration has been opposed by Isolab, Inc. on the ground that applicant's mark, when applied to applicant's

[1] Application Serial No. 74/535,956, filed June 8, 1994, alleging a bona fide intention to use the mark in commerce.

goods, so resembles opposer's previously used mark LDL-DIRECT for blood testing equipment and reagents, including in vitro cholesterol test kits, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Applicant, in its answer, denied the salient allegations of likelihood of confusion.

The record consists of the pleadings; the file of the involved application; trial testimony, with related exhibits, taken by each party; applicant's answers to opposer's first set of interrogatories and a copy of an Office action issued in opposer's application Serial No. 74/561,450, introduced by way of opposer's notice of reliance; and opposer's responses to certain of applicant's interrogatories, and excerpts from printed publications made of record in applicant's notice of reliance. The parties filed stipulated protective agreements covering some of the trial evidence. Both parties filed briefs on the case, and both were represented by counsel at an oral hearing held before the Board.

At the outset, we need to consider a procedural point regarding applicant's assertion that opposer's mark is deceptively misdescriptive under Section 2(e)(1) or deceptive under Section 2(a) These issues were not pleaded in applicant's answer nor any amended answer, but rather were raised for the first (and only) time in applicant's

final brief on the case. Although we cannot condone applicant's failure to amend its pleading to put opposer on adequate notice that opposer's proprietary rights in its mark were under attack, opposer, in its reply brief, has not raised any objection to the interjection of these issues at this late date. Nor was any objection raised by opposer at the oral hearing. Opposer, in its reply brief and at the oral hearing, addressed the merits of the newly raised claims. Although we have doubts about whether the issues were "tried" as contemplated under Fed. R. Civ. P. 15(b), we will take up, given opposer's amenability to have the issues considered at final hearing, the merits of applicant's allegations as if the issues were tried by the parties.

Opposer, according to the testimony of Loren Hazelwood, opposer's vice president of operations, is engaged in the sale of products for biomedical research and diagnostic testing by clinical laboratories. The primary customers for opposer's products sold under the mark LDL-DIRECT are clinical labs, reference labs and research scientists. The products are promoted by direct mailings, catalogs, product brochures, newsletters and appearances at trade shows.

Applicant, according to the testimony of Jerome Casey, applicant's vice president--sales and marketing, sells diagnostic products, including an in vitro diagnostic product for the quantitative determination of LDL (low

density lipoproteins) cholesterol. This cholesterol is the so-called "bad" cholesterol (as opposed to HDL cholesterol, high density lipoproteins, the so-called "good" cholesterol). The product sold by applicant under the mark DIRECT LDL contains reagents which, when used by a clinician to treat a serum specimen taken from a patient, produces a sample containing only LDL cholesterol. Purchasers of applicant's product are typically clinical and hospital labs which are reporting out cholesterol values to ordering physicians. The product is promoted through direct mailings, catalogs and appearances at trade shows.

We first turn our attention to applicant's attacks on opposer's pleaded mark since these allegations have a direct bearing on opposer's proprietary rights in the mark which opposer needs to establish in order to prevail on its likelihood of confusion claim. Towers v. Advent Software, Inc., 913 F.2d 942, 16 USPQ2d 1039 (Fed Cir. 1990); and Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 209 USPQ 40 (CCPA 1981).

It is clear from applicant's late interjection of the issues of deceptive misdescriptiveness and deceptiveness that they are subordinate to the main issue of likelihood of confusion. More significantly, the record clearly establishes that opposer's mark does not suffer from either of the infirmities alleged by applicant.

The essence of applicant's arguments is that opposer's product is used for separating the alpha and beta fractions of cholesterol in human serum, and that this product is not used to obtain or measure LDL cholesterol. Further, according to applicant, purchasers are likely to believe that opposer's product has something to do with LDL cholesterol. With regard to deceptiveness, applicant contends that due to the need in the marketplace for a product that measures LDL cholesterol, purchasers will be affected in their purchasing decision by opposer's misdescription of its product as relating in some respect to LDL cholesterol.

The test for deceptive misdescriptiveness involves two questions. (1)is the term misdescriptive of the character, quality, function, composition or use of the goods?; and (2)if so, are prospective purchasers likely to believe that the misdescription actually describes the goods? A third question, used to distinguish between terms that are deceptively misdescriptive under Section 2(e)(1) and terms that are deceptive under Section 2(a), is whether the midescription is likely to affect the decision to purchase the goods. In re Budge Manufacturing Co. Inc., 857 F.2d 773, 8 USPQ2d 1259 (Fed. Cir 1988).

We see no reason to go into great detail about the clear lack of merit of applicant's claims. According to Mr.

Hazelwood, opposer's product is used in the separation of the alpha and beta fractions of cholesterol in human serum, and the beta fraction is considered an LDL factor. (see also Hazelwood dep., ex. no. 9) Thus, opposer's product, in point of fact, has something to do with LDL cholesterol. As such, opposer's LDL-DIRECT mark is not misdescriptive of the goods, and applicant's claims must fail. Moreover, as noted above, we cannot overlook the fact that these claims were initially raised at a manifestly late juncture of the proceeding, almost as throwaway claims, with applicant pointing to a mere few pages of testimony as the proof for its claim. Simply put, the proof falls far short.

We next turn to the priority and likelihood of confusion claim under Section 2(d). There is no issue of priority of use in this case Applicant does not dispute, and the record establishes, that opposer's use of LDL-DIRECT predates applicant's first use of its mark DIRECT LDL.[2]

Our determination under Section 2(d) of the Act is based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). The

[2] Even if we were convinced by applicant's deceptive misdescriptiveness claim, the record establishes that opposer's mark had acquired distinctiveness at a time prior to the earliest date upon which applicant is entitled to rely in this proceeding.

factors deemed pertinent in the proceeding now before us are discussed below.

With respect to the marks, applicant argues in vain that the dominant portion of its mark is "DIRECT" whereas the dominant portion of opposer's mark is "LDL." The marks, when considered in their entireties as applied to the goods, engender substantially similar overall commercial impressions. The connotation of opposer's mark is virtually identical to the connotation of applicant's mark. The only real difference between the marks is that the two words comprising the marks are transposed. This difference is minor, as it relates to the overall commercial impressions conveyed by these marks. In re Wines Society of America Inc., 12 USPQ2d 1139 (TTAB 1989), and Bank of America National Trust and Savings Association v. American Bank of St. Joseph, 201 USPQ 842 (TTAB 1978)[confusion is likely where the sole significant difference between marks applied to *similar goods or services is the transposition of the* words which comprise those marks and where the transposition of words does not change the overall commercial impression].

We next turn to consider the goods sold under the marks. We start with the premise that the goods need not be identical or even competitive to support a holding of likelihood of confusion. It is sufficient that the goods are so related or that conditions surrounding their

marketing are such that they are encountered by the same persons who, because of the relatedness of the goods and the similarities between the marks, would believe mistakenly that the goods originate from or are in some way associated with the same producer. Hercules Inc. v. National Starch and Chemical Corp., 223 USPQ 1244, 1247 (TTAB 1984).

In the present case, applicant's brief is silent on this du Pont factor. The record establishes that opposer's in vitro blood testing product is used to determine the beta fraction, which is a component part of LDL cholesterol. The beta fraction refers to chylomicrons, very low density lipoproteins and low density lipoproteins cholesterol. Applicant's product, according to Mr. Casey, offers users a method to directly measure LDL as a discrete component of cholesterol. In sum, the goods are substantially similar in their nature and function in that both are used to obtain LDL cholesterol values, albeit in different manners. Further, as shown by the record, the products of the parties move in the same channels of trade and are purchased by the same types of laboratories.

The parties agree that these common purchasers for their products are well informed and are sophisticated at making purchasing decisions. Nonetheless, this factor is not determinative inasmuch as even sophisticated purchasers are not immune from confusion as to source In re Pellerin

Milnor Corp., 221 USPQ 558 (TTAB 1983). We find this to be especially the situation in cases such as the present one where the marks and the goods sold thereunder are substantially similar.

In reaching our conclusion, we acknowledge that neither party is aware of any instances of actual confusion between the marks during the three years of contemporaneous use. Although this factor weighs in applicant's favor, evidence of actual confusion, as often stated, is difficult to obtain. In any event, such evidence is unnecessary since the test under Section 2(d) is not actual confusion but likelihood of confusion.

We conclude that purchasers familiar with opposer's blood testing product sold under its mark LDL-DIRECT would be likely to believe, upon encountering applicant's mark DIRECT LDL for diagnostic reagents for the immunoseparation of cholesterol components in vitro, that the respective goods originated with or were somehow associated with or sponsored by the same entity.

Decision: The opposition is sustained and registration to applicant is refused.

R. L. Simms

T. J. Quinn

P. T. Hairston
Administrative Trademark
Judges, Trademark Trial
and Appeal Board